

## REMARKS

These remarks are responsive to the Office action dated January 30, 2006. Claims 1, 3-22, 25, 32, 45, 52 and 53 are now pending in the application. Claims 1, 3-22, 25, 32, 45, and 52 stand rejected. In particular, claims 5, 6 and 10 are rejected under 35 U.S.C. § 112, second paragraph; claims 25 and 45 stand rejected under 35 U.S.C. § 102; and claims 1, 3, 4, 7-22, 32, and 52 are rejected under 35 U.S.C. § 103(a). None of the pending claims are cancelled in this Amendment. Applicant has amended claims 5 and 10, and added a new claim 53. In view of the above amendments and the following remarks, Applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Before getting into a discussion of the Office action, Applicant notes that claims 25, 32 and 52 have been amended to correct several typographical errors that occurred in combining claims for allowance. In Applicant's response to the final Office action dated November 29, 2004, Applicant incorporated the elements of claims 23 and 24 into claim 25 in order to place it in condition for allowance. In the November 29, 2004 final Office action, the Examiner indicated that if such amendments were made, claims 25, 32 and 52 would be in condition for allowance. The present amendments made to claims 25, 32 and 52 have not in any way changed the substance or scope of the claims. Rather, the changes simply make the claims more readable and easier to understand. They are not made in an attempt to distinguish the prior art or overcome a rejection based upon prior art. Applicant is of the position that the below arguments sufficiently overcome the Examiner's rejections.

**Rejections under 35 U.S.C. § 112**

The Examiner has rejected claims 5, 6 and 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. The Examiner indicates that the preamble of claim 5 defines a “stockpiling conveyor,” but claim 5 depends from a claim defining a “portable trommel” in its preamble. The Examiner suggests that claim 6 is similarly flawed as it defines a “portable trommel.” Regarding claim 10, the Examiner contends that the recited term “first” is unclear.

Without acknowledging the propriety of the rejection, Applicant has amended claims 5 and 10 in order to more particularly define the invention. In particular, the preamble of claim 5 has been amended to define a “portable trommel” and recite “the lower end of the first lower part of the stockpiling conveyor.” Subsequent to the amendment, claim 5 defines the same subject matter as the claim from which it depends. The amendments made to claim 5 should also resolve any confusion concerning claim 6, as both claims 5 and 6 now define the same subject matter. Further, claim 10 has been amended to correct a typographical error that has persisted since the ‘950 patent issued. Claim 10 now recites “the stockpiling conveyor,” which should alleviate any confusion concerning where “an actuation means” is included.

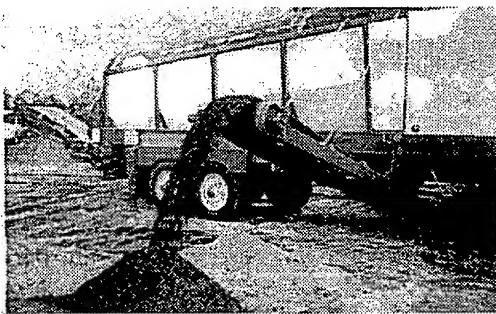
Applicant suggests that, in view of the above amendments and remarks, claims 5, 6 and 10 particularly point out and distinctly claim the subject matter of the invention. Applicant therefore respectfully requests the withdrawal of the rejection of claims 5, 6 and 10 under 35 U.S.C. § 112, second paragraph. Applicant further requests that the Examiner issue a Notice of Allowability for claims 5 and 6, as the Examiner noted that

those claims would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph.

**Rejections under 35 U.S.C. § 102**

Claims 25 and 45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Re-Tech Eliminator (Re-Tech). The Examiner suggests that the Re-Tech reference discloses all the elements of the portable trommel defined in both claims 25 and 45. Regarding claim 45, the Examiner further contends that the Applicant has not sufficiently specified a relative plane (i.e., horizontal or vertical) for the axes recited, therefore the Re-Tech conveyor can be considered to articulate about the claimed axes. Applicant respectfully disagrees and traverses the rejection of claims 25 and 45 under 35 U.S.C. § 102(b).

Claim 25 of the application recites “a stockpiling conveyor mounted on the other end of the chassis.” To clarify, “the other end” recited is the end of the chassis opposing the end that the rejected material conveyor is mounted. Accordingly, the portable trommel of claim 25 has a rejected material conveyor mounted at one end of the chassis and a stockpiling conveyor mounted at the other end.



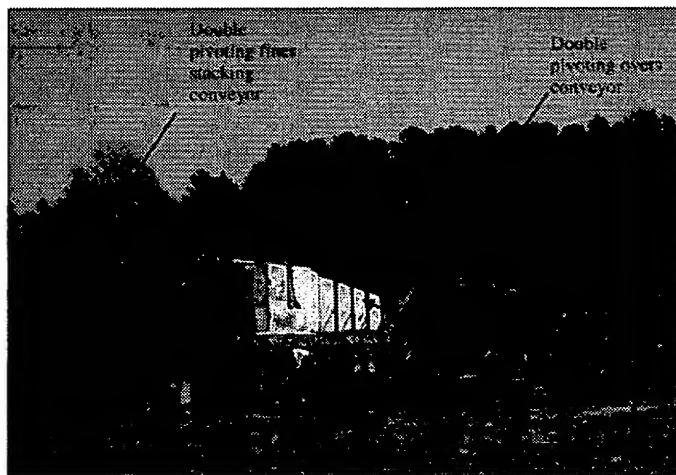
The Re-Tech trommel (pictured above) relied upon by the Examiner in rejecting claim 25 does not disclose a stockpiling or “fines” conveyor mounted at an end of the chassis. Rather, the Re-Tech reference, as shown in the picture above, discloses a

stockpiling or “fines” conveyor mounted on the side of the chassis. As the Re-Tech reference does not anticipate Applicant’s claimed portable trommel, Applicant respectfully asserts that the Examiner’s 35 U.S.C. § 102(b) is improper.

With regard to claim 45, there is recited “a deployable elongate conveyor having first and second elongate components where the first component is mounted on the chassis adjacent the output end of the trommel and is movable relative to the chassis about angularly displaced first and second axes, and where the second component articulates with the first component about a third axis, that is generally parallel to the second axis, as the conveyor moves between a deployed and stowed condition.” Claim 45 clearly recites a deployable elongate conveyor that moves or articulates about three distinctly defined axes. The Re-Tech reference does not disclose such a feature and therefore cannot be said to anticipate the portable trommel of claim 45.

Claim 53 has been added to the pending application in response to the Examiner’s comments in the Office action. Specifically, the Examiner stated that claim 45 would be allowable if it were to define specific planes of movement in regards to the conveyor. Claim 53 depends from independent claim 45, and was added to more narrowly define the precise axes of rotation and planes of movement recited in claim 45. Applicant contends that claim 45 is in condition for allowance, as the first, second, and third axes recited clearly and distinctly claim the movement of the conveyor and are supported in the specification. The axes of rotation define the planes of movement of the conveyor and, therefore, the specific planes of movement do not need to be recited where the axes are defined.

The trommel pictured in the Re-Tech reference does not disclose all of the features enumerated in pending claim 45. Specifically, the conveyors shown in the Re-Tech reference do not move relative to three distinctly defined axes. Both the “fines” conveyor and the “overs” conveyor move relative to two axes. As much is admitted by the references cited by the Examiner, which are shown below referring the conveyors as being “double pivoting.”



Because the Re-Tech reference discloses conveyors rotatable or articulable about only two axes, Applicant respectfully asserts that rejection of claim 45 under 35 U.S.C. § 102(b) is improper.

In light of the above remarks, Applicant respectfully asserts that neither claim 25 nor 45 is anticipated by the Re-Tech reference. Accordingly, the Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 102(b) rejection of claims 25 and 45.

#### **Rejections under 35 U.S.C. § 103**

Claims 1, 3, 4, 7-22, 32 and 52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Re-Tech in view of U.S. Patent No. 5,193,971 (Pettijohn) and Cedarapids. The Examiner concludes that it would have been obvious at the time the

invention was made to one of ordinary skill in the art to combine Pettijohn and/or Cedarapids with Re-Tech. Applicant respectfully disagrees and traverses rejection of claims 1, 3, 4, 7-22, 32 and 52 under 35 U.S.C. § 103(a).

First, Applicant respectfully contends that the Examiner's rejection was improper under 35 U.S.C. § 103 as it was the result of impermissible hindsight reconstruction. Second, Applicant respectfully submits that both Pettijohn and Cedarapids are non-analogous art and therefore cannot be used to reject the pending claims as being obvious. Finally, Applicant respectfully asserts that combining the references cited by the Examiner would result in an inoperable invention.

#### **Hindsight Reconstruction**

The "motivation-suggestion-teaching" requirement attempts to prevent hindsight reconstruction from becoming the basis for a rejection under 35 U.S.C. § 103. Under this requirement, it is not enough for an Examiner to simply identify all of the elements of a claim in the prior art. Rather, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 based upon a combination of elements found in the prior art, the basis relied upon for the obviousness rejection must be articulated. See *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006). Without an articulation of the motivation, suggestion, or teaching, which made an applicant's invention obvious, the Federal Circuit has stated it will presume impermissible hindsight was used in rejecting the claims as obvious. *Id.*

In applying the "motivation-suggestion-teaching" legal standard, Applicant respectfully disagrees with the Examiner's assertion that the combination of the Re-Tech, Pettijohn, and Cedarapids references renders the pending claims obvious. None of the aforementioned references, nor the collective disclosures of the references, provide the

required motivation, suggestion, or teaching required to make the combination obvious under 35 U.S.C. § 103.

Hindsight reconstruction has been proscribed, in part, to prevent picking and choosing elements from different prior art references in order to reject an application as obvious. Here, the Examiner has picked a trommel vehicle (Re-Tech) and combined it with an impact breaker with a conveyor that rotates about a vertical axis (Cedarapids) and an unloading conveyor which rotates about a vertical axis and has two, pivotally attached components (Pettijohn). Applicant respectfully submits that the Examiner has simply picked elements from prior art references that contain similar features as the present portable trommel and combined them to formulate a 35 U.S.C. § 103 rejection.

Moreover, at no point in the Office action does the Examiner articulate a proper suggestion, teaching, or motivation to combine the references to achieve the claimed portable trommel. It can, therefore, be assumed that the Examiner used impermissible hindsight reconstruction to reject the above-mentioned claims as obvious. For at least this reason, Applicant respectfully contends that claims 1, 3, 4, 7-22, 32 and 52 not obvious in light of the cited references, and are in condition for allowance.

#### **Non-analogous Art**

The “Analogous Art” test requires that, “In order to rely on a reference as a basis for rejection..., the reference must either be in the field of applicant’s endeavor, or if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically

would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. *Id.* If a reference's disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. *Id.* If an invention is directed to a different purpose, the inventor would have had less motivation to consider it. *Id.*

As is stated in the present reissue application and prior correspondence with the Examiner, trommel equipment has traditionally been used to sort and filter objects by size. The present reissue application cites construction, waste disposal, landscaping, and building demolition as industries that use trommel equipment frequently. The Kuhmonen reference (U.S. Pat. No. 5,248,042), cited as prior art by the Examiner in a previous Office action, further mentioned processing yard waste, wet mulch, and mixtures of soil, rock, stumps, brush, and vegetation, cleared from raw land subject to development, (col. 1, ll. 9 – 13), and recycling, processing of garbage, solid waste, and raw product of automobile shredding operations, (col. 1, ll. 17 – 23), as potential uses of trommel equipment.

The Federal Circuit has stated that in the appropriate "field of endeavor" of an invention is determined "by reference to explanations of the invention's subject matter in the patent application, including embodiments, function, and structure of the claimed invention." *In re Bigio*, 381 F.3d 1320, 1325-26 (Fed. Cir. 2004). Applicant respectfully asserts that neither Pettijohn nor Cedarapids are within the inventor's field of endeavor.

Indeed, neither Pettijohn nor Cedarapids are trommels. Rather, Pettijohn discloses a conveyor for unloading and dispersing material from the back of a truck or similar vehicle, and Cedarapids discloses an impact breaker for crushing rock in a quarry. Applicant contends that the embodiments, function, and structure described in the present application do not place it within the same “field of endeavor” as Pettijohn or Cedarapids. Accordingly, it must be determined whether Pettijohn or Cedarapids are reasonably pertinent to the problem the inventor attempts to solve.

The stated purpose of the present portable trommel is to provide for both a rejected material conveyor and a stock piling conveyor that each has lower and upper portions that can be folded next to and/or over the trommel chassis so that the entire trommel can be transported from one location to another without damaging the conveyors. Inherent in the purpose of a trommel is to sort and separate materials into separate piles. These purposes are not suggested, nor similar to the purpose of the Examiner’s cited references.

The design and purpose of Pettijohn is to provide a stronger conveyor apparatus that is able to laterally fold out to dispense the contents of a truck. The conveyor does not suggest a conveyor that “move[s] upwardly and outwardly from the chassis” as is required in claim 1, thereby providing a conveyor that can create radial piles of material. Rather, the Pettijohn conveyor moves horizontally from the vehicle chassis and simply provides a structure that unloads the contents of a truck.

Similarly, the purpose of the Cedarapids reference is not reasonably pertinent to the problems addressed by the inventor. Cedarapids provides an impact breaker for use in a quarry. There is no sorting and/or separating of materials into different piles as is the

general purpose of a trommel. These endeavors are quite separate from one another and would not lend themselves as a source of knowledge to an inventor in the field of trommels.

As the fields of endeavor and the general purposes of the references and the present portable trommel are not the same, the references cannot properly be asserted as the basis of a rejection under 35 U.S.C. § 103. Accordingly, Applicant respectfully requests that the Examiner withdraw his obviousness rejection for at least the reason that the references do not constitute analogous art under the test articulated by the Federal Circuit.

#### **Inoperable Result**

To properly apply 35 U.S.C. § 103, the cited references must suggest the desirability, and thus, the obviousness of making the combination. Simply put, there must be some teaching or suggestion to combine the cited references. Such a requirement serves to prevent against the benefit of impermissible hindsight vision afforded by the disclosure. See *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994) and *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986). The Federal Circuit further clarified this teaching requirement of obviousness in *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1353-54 (Fed. Cir. 2001) in stating that:

We have noted elsewhere, as a ‘useful general rule,’ that references that teach away cannot serve to create a prima facie case of obviousness. If references taken in combination would produce a ‘seemingly inoperative device,’ we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.

*Id.* at 1354 (citations omitted). Thus, it is impermissible to consider an inoperable combination of references as rendering a claim obvious under 35 U.S.C. § 103.

Applicant respectfully contends that an attempt to combine the Re-Tech trommel device with the Pettijohn and Cedarapids references would result in an inoperable piece of equipment. This hypothetical combination would have resulted in a trommel with a radially stockpiling conveyor positioned on one side of the chassis. As can be seen in the photograph of the Re-Tech reference (above in § 102 remarks), there is limited space beneath the chassis of the portable trommel. Certainly the area available is not adequate to house the base of a radial stockpiling conveyor and the configuration of belts and other necessary components. Such a combination would be inoperable. Under the standard set forth by the Federal Circuit, such a combination would teach away from combining the cited references and therefore would not provide the proper bases for an obviousness rejection under 35 U.S.C. § 103. For at least this reason, claims 1, 3, 4, 7-22, 32 and 52 are not obvious over Re-Tech in view of Pettijohn and Cedarapids, and are in condition for allowance.

In accordance with 37 C.F.R. § 1.173(c), a Claims Status List, including support for any claim changes, has been included in this response.

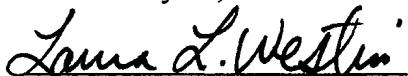
Further, an executed supplemental reissue oath/declaration under 37 C.F.R. § 1.175(b)(1) is enclosed with this response.

Applicant believes that this application is now in condition for allowance, in view of the above remarks and amendments. Accordingly, application respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of this application, please contact the undersigned attorney of record.

The commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 11-1540. A duplicate copy of this sheet is enclosed.

**CERTIFICATE OF MAILING**

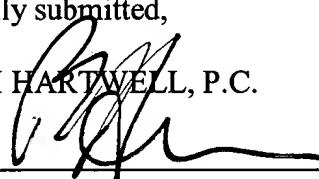
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop REISSUE, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on July 31, 2006.



Laura L. Westin

Respectfully submitted,

KOLISCH HARTWELL, P.C.



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